Remarks

Applicant has amended Claim 11 to correct typographical errors that occurred during a prior amendment. No new matter has been added.

The Section 102 Rejection

The Examiner has rejected claims 1-3 as anticipated by U.S. Patent 4,269,008 to Assouline. As repeatedly indicated by the courts, anticipation requires that all of the elements and limitations of the claims be found within a single prior art reference. There must be no difference between the claimed invention and the disclosure provided by the reference, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Found. v. Genentech, Inc., 927 F.2d 1565 (Fed. Cir. 1991). Applicant respectfully submits that the Examiner has misinterpreted Assouline and that Assouline does not teach every element of the claims; therefore, the invention, as claimed herein, is not anticipated by Assouline.

According to the Examiner, Assouline discloses a method of discouraging the roosting of birds by identifying a roosting zone "and applying a slide (Fig 1:7 and 4:2) sheet which comprises angled slick outer faces." Applicant respectfully submits that the Examiner has failed to show the presence in Assouline of all the limitations of claim 1. Claim 1 recites:

> 1. A method of discouraging the roosting or nesting of birds on structures comprising the steps of identifying roosting zones on the structure and applying thereto a slide comprising a formed sheet of material having a slick outer face and mounted to impose a plurality of angled slide surfaces that inhibit a bird's standing.

The Examiner's rejection of Claim 1 stems from a misreading of the claim coupled with a misunderstanding of what Assouline discloses. Claim 1 calls for applying a slide to the identified roosting zone. "Slide" is a defined term, meaning "a sheet of material having a slick

outer surface and mounted at an angle so that a pigeon slides downward under the force of gravity and cannot stand still on the surface without effort" [Specification, ¶19]. The slide of Claim 1 is mounted to "impose a plurality of angled surfaces."

Assouline does not disclose application of a slide to roosting zones. Indeed, Assouline teaches away from applying a slide, indicating that "inclined planes or strips of triangular shape with the point upward" are not a panacea [Col 1, l 33-46]. Instead, Assouline teaches applying a series of polyhedrons with pointed tops and transparent lateral faces. According to Assouline, the optical phenomenon, particularly by refraction, caused by the orientation of the faces and the transparent material, frightens the birds so they do not land there.

The examiner erroneously points to what he thinks is a slide sheet at Fig 1:7 and Fig 4:2 of Assouline. These are decidedly not "slide sheets," and the bird never touches them or slides on them. As described by Assouline, item 2 is a support base on which the successive transparent polyhedra are fitted [Col 2 l 60-62] and item 7 is a bridge flange that connects two polyhedra [Col 2, l 63-65]. The polyhedra bases are "less than 3 centimeters apart" [Col 3, l 9-11], so no bird can set foot on the flange or base between the polyhedra. A fortiori, no bird can slide downward under the force of gravity at these locations.

The Examiner also incorrectly identifies item 4 of Assouline's Fig 2 as "angled slick outer faces" corresponding to Applicant's "plurality of angled slide surfaces that inhibit a bird's standing." First, nothing in Assouline suggests that the outer surfaces of the polyhedron should be "slick." The crux of Assouline's disclosure is that the polyhedra faces be transparent so they create an optical effect that frightens birds [Col 3, l 13-14 ("The material used can be of any nature provided it exhibits faces able to give a prism effect")]. Moreover, the angled faces (4) are plainly not configured to cause alighting birds to slide on them. Assouline involves a

crowded series of "closely spaced, upwardly extending structures surmounted with pyramids, the angles of which are such that a prism effect is created which serves to optically frighten the birds" [Abstract].

Applicant notes that the above discussion does not rely upon the "formed" nature of the sheet in claim 1 but advises that the term does not refer to the method of construction of the sheet but rather that its structure is already characterized (i.e., has a form) before the sheet is applied to the roosting zone. In any event, the limitation is not necessary to distinguish the Assouline reference.

Claims 2-5 and 10 depend from Claim 1 and are not anticipated where Claim 1, as shown, is not anticipated. Regarding Claims 3 and 5, Applicant respectfully submits that the Examiner misapprehends the standard terminology of solid geometry. A "prism" is a polyhedron with two congruent, parallel faces (called the bases) and whose lateral faces are parallelograms. A "triangular prism" is a prism whose bases are triangles. Applicant's Fig 4A shows a triangular prism; side 126 (and the other two sides) are parallelograms, and bases 129 and 130 (which may optionally be open or closed [Specification ¶024]) are triangles. Triangular prisms are also shown in Applicant's Fig 2, items 114 and 115. No such shape appears anywhere in the disclosure of Assouline. It is possible that the Examiner has confused the reference to "prism effect," which is an optical light-scattering phenomenon, with the geometric term.

Regarding Claim 10, the Examiner states that a partial pyramid is disclosed by Assouline's Fig 1 if the angled surface of the top portion 5 would be extended to base 7. This is not proper argument in a Section 102 rejection. The reference must itself contain all the limitations of the claim, and the Examiner cannot at his discretion modify the reference to make it correspond to the claim.

The Section 103 Rejections

The Examiner has rejected Claim 11 as unpatentable over Assouline under 35 USC 103(a) and has rejected Claim 12 as unpatentable over Assouline in view of U.S. Patent 6,546,676 to Wiesener, et al.

With respect to the rejection of Claim 11 over Assouline as modified by an "obvious design choice," the Examiner must meet the standard for relying on common knowledge to augment a reference. This is permissible only where the modification is "capable of instant and unquestionable demonstration of being known" MPEP 2144.03(A). The addition of an element cannot be justified as based on "good common sense." In re Zurko, 258 F.3d 1379 (Fed Cir 2001).

Claim 11 calls for, *inter alia,* applying to the roosting zone a slide (a slick sheet mounted to impose an angled surface) comprising "a sheet that follows the slope of the rooftop structure." As explained in the specification, the natural slope of the roofline provides the slant or angle leaving the slick surface unsuitable for roosting [Specification ¶ 0029 and Fig. 7]. The Examiner's statement that it would be an obvious design choice to apply Assouline's structure so that its "angled dimensions" follow the roof slope is nonsensical. In the first place, as demonstrated above, Assouline does not disclose a sheet having a slick outer surface at all. Assouline discloses a multitude of pyramid protrusions with transparent faces closely bunched side-by-side. These cannot in any way be characterized as a sheet following the slope of a roofline. Moreover, there is no suggestion whatsoever that any of the angled pyramid surfaces (e.g., surface 4 in Fig. 1) should follow any roofline. The purpose of the orientation of the faces is to create an optical phenomenon [Col 2, l 12-14], which is completely unrelated to any roofline.

With respect to Examiner's rejection of Claim 12 under 35 U.S.C. 103(a), "in proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art." In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). "[I]dentification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant." In re Kotzab, 217 F.3d 1365, 1369-70, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000).

An adequate showing of motivation to combine requires "evidence that 'a skilled artisan,' confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." Ecolochem, Inc. v. Southern Calif. Edison Co., 227 F.3d 1361, 1375, 56 USPQ2d 1065, 1075 (Fed. Cir. 2000) (quoting In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998)). "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight." In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

The Examiner has rejected claim 12 as obvious over Assouline in view of U.S. Patent 6,546,676 to Wiesener et al. The Examiner's reasoning is utterly faulty. Claim 12 recites applying a bead of silicone around the periphery to prevent anchoring of nesting materials. According to the Examiner, one would use Wiesner's silicone adhesive as a "weather resistant

seal "to keep out water," but there is no reason to even consider putting a weather resistant seal on a sheet that sits on top of a roof slope (which should already be weather resistant).

Additionally, claim 12 is dependent from claim 11 and therefore is allowable because claim 11 is allowable.

Applicant respectfully submits that claims 1-5 and 10-12, as amended, are shown by the foregoing to be in proper form, supported by the specification, and novel and unobvious in light of the references cited and those references considered pertinent to Applicant's disclosure. Thus, Applicant submits that the present application is in condition for allowance. Favorable reconsideration and withdrawal of the objections and rejections set forth in the above-noted Office Action and a Notice of Allowance are requested.

Respectfully submitted,

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